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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/779,643	02/09/2001	Hiroaki Ishii	03500.015106.	6215
5514 7590 04/11/2008 FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112				
EXAMINER				
DUNHAM, JASON B				
ART UNIT		PAPER NUMBER		
3625				
MAIL DATE		DELIVERY MODE		
04/11/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

09/779,643

**Applicant(s)**

ISHII ET AL.

**Examiner**

JASON DUNHAM

**Art Unit**

3625

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 January 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 45, 46, 48-50, 54-56 and 60 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 45, 46, 48-50, 54-56 and 60 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

***Response to Amendment***

Applicant amended claims 1, 45, 46, 48-50, 54-56, and 60 and canceled claims 47, 51-53, 57-59, and 61-63. Claims 1, 45, 46, 48-50, 54-56, and 60 are pending.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 1, 45-46, 48-50, 54-56, and 60 are rejected under 35 U.S.C. 102(b) as being anticipated by Yamashita (US 5,708,909).**

Referring to claim 1. Yamashita discloses a management system, connected to a communication line, for managing maintenance of a plurality of printing apparatuses, comprising:

- A reception unit that receives a first ID for specifying a first printing apparatus having use history information showing that the first printing apparatus was managed and a second ID for specifying a second printing apparatus as an apparatus to be newly managed, the first ID and the second ID being transmitted via the communication line, and the first printing apparatus and the second printing apparatus being different from each other (abstract, figures 1 and 3);

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- A search unit that searches for first information related to a contract corresponding to the first ID received by said reception unit (figure 8); and
- A generation unit that generates second information related to a contract for the second printing apparatus, based on the first information searched by said search unit and machine types of the first and second printing apparatus, wherein said generation unit further generates display information for displaying the generated second information (column 8, lines 7 - 59); and
- A transmission unit that transmits the display information generated by said generation unit via the communication line , wherein the contract is related to at least one of contract term and maintenance of the printing apparatus (figure 8, "lease contract expiry").

Referring to claims 45-46. Claims 45-46 are rejected under the same rationale set forth above.

Referring to claim 48. Yamashita discloses all of the limitations of claim 48 as noted in the rejection of claim 1 above and further discloses a second reception unit that receives a user instruction indicating whether or not a new contract for the second printing apparatus is to be made based on the contract for the first printing apparatus (figures 6 and 9) and generating information based on machine types of the printing apparatuses (figures 1 and 8). Yamashita discloses a record of initialized but unregistered printers that are compared with the registered printers at each lease company and therefore Yamashita would inherently based the newly registered printers contracts on previously registered printer contracts. Furthermore, the examiner notes

that the newly added limitation, "wherein said generation unit...." is a recitation of the intended use of the claimed invention which must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Referring to claims 49-50, 54-56, and 60. Claims 49-50, 54-56, and 60 are rejected under the same rationale set forth above in the rejection of claims 1 and 48.

### ***Response to Arguments***

Applicant's arguments filed January 11, 2008 have been fully considered but they are not persuasive. Applicant argues that Yamashita does not disclose a newly managed second apparatus with a distinct ID. The examiner submits, as noted above in the rejection of claims 1 and 48, that Yamashita discloses managing multiple printing apparatuses each assigned a unique ID as they are installed (see at least abstract, figure 1, and column 2, lines 4 - 25). Applicant's arguments regarding a generation unit for contracts of second printing apparatus are addressed in the rejection of claim 48. The similar independent claims 45, 46, 54, and 60 as well as their dependents are rejected under this same rationale.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JASON DUNHAM whose telephone number is (571)272-8109. The examiner can normally be reached on M-F, 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JBD  
Patent Examiner  
4/2/08

/Jeffrey A. Smith/  
Supervisory Patent Examiner, Art Unit 3625